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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,054	02/12/2002	Herbert Herzog	1871-132	5105
6449	7590	01/16/2004	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			SHUKLA, RAM R	
			ART UNIT	PAPER NUMBER
			1632	
DATE MAILED: 01/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,054

Applicant(s)

HERZOG ET AL.

Examiner

Ram R. Shukla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

1. Claims 1-46 are pending in the instant application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-11, 16, 17, 19, drawn to a GPR56 polynucleotide and a gene construct comprising the polynucleotide, classified in class 536, subclass 23.1.
- II. Claim(s) 11-14, drawn to a GPR56 polypeptide, classified in class 530, subclass 350.
- III. Claim(s) 15, drawn to an antibody to a GPR56 polypeptide, classified in class 530, subclass 387.1.
- IV. Claims 18 and 20, drawn to a GPR56 probe comprising the sequence of a certain SEQ ID NO, classified in class 536, subclass 24.31.
- V. Claims 21-41, drawn to a diagnostic method of determining the level of GPR56 mRNA in a test sample, classified in class 435, subclass 5.
- VI. Claims 42-46, drawn to a method for detecting a cancer cell in a subject by determining the level of a GPR56 polypeptide, classified in class 435, subclass 7.1.

3. It is noted that the invention of group comprises nine patentably distinct sequences that are disclosed in different SEQ ID Nos and therefore will require a separate search in the databases and the search for one will not yield art related to the other. Therefore, applicants are required to elect on SEQ ID NO for further prosecution. It is emphasized that this is not species election, rather a restriction.

4. The inventions of the groups I-IV are drawn to compositions that have materially different structure and different physical and chemical characteristics. Additionally, they have different mode of action and will have distinct utilities. For

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example, the utility of a nucleic acid will be distinct from that of a protein or an antibody. Furthermore, their search in the patent and non-patent literature will not be co-extensive.

The inventions of the groups V and VI are drawn to methods that require different reactants and also would require different steps. For example, a step of nucleic acid hybridization cannot be used in a method of determining protein.

The inventions of the groups I-IV are patentably distinct from the methods of the groups V and VI because the methods cannot be used for producing the compositions. While the methods of group V can be practiced by using the nucleic acid of group I, it can be practiced using the probe of group IV as well. Additionally, while the method of group VI can be practiced using the antibody or the polypeptide groups II and III respectively, these compositions have multiple uses.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on

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(703) 305-4051. The fax phone number for TC 1600 is (703) 703-872-9306. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the William Phillips whose telephone number is (703) 305-3413.

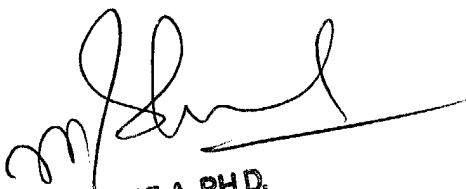
Please note that effective January 13, the offices for Examiner Shukla, SPE Reynolds and LIE William Phillips will move to the new USPTO location in Alexandria, VA and their phone numbers will change. The new phone numbers will be as follows:

Ram Shukla: **(571) 272-0735**

Deborah Reynolds: **(571) 272-0734**

William Phillips: **(571) 272-0548**

Ram R. Shukla, Ph.D.
Primary Examiner
Art Unit 1632



RAM R. SHUKLA, PH.D.
PRIMARY EXAMINER